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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/149,448	09/09/1998	MICHAEL S. BATTAGLIA	264-146	5036

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 08/22/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/149,448**

Applicant(s)  
**Battaglia et al.**

Examiner  
**Boccio, Vincent**

Art Unit  
**2615**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 16 recites the limitations "said first digital memory" and "said second digital memory in line 7; and "said first and second memory ports", in line 8.

There is insufficient antecedent basis for these limitations in the claims.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless --  
(e) the invention was described in-  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).
5. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al. (US 6,256,063).

Regarding claims 1 and 3-5, Saito discloses and meets the limitations associated with a portable, hand held, digital camera picture image data transfer and repository device for use with a removable memory module of a digital camera, comprising:

a housing of a size to be held in a user's hand and including a memory input port sized to receive a digital camera memory module(Fig. 1, "portable hand held repository device 30 or a {LapTOP computer}", "port 31", memory module 20);

a mass storage device(the LapTOP provides storage for images stored on the card, therefore, meeting the limitation of a repository device, col. 8, unit 30, {LAPTOP/PDA etc.....}, col. 10, lines 22-, col. 11, lines 45-), coupled to receive and store picture image data from the camera memory module, inserted into the memory port; and

data transfer circuitry for controlling the transfer of data stored in the module inserted in to the memory port(Fig. 2, etc....); wherein the LapTOP is provided with keys for transferring to the LapTOP(col. 11, since images are requested from a user, it is considered to be inherent, that the request must come a means such as from, the key board of the LapTOP in view of no other means provided to the user to request or initiate the transfer of stored images, when the LapTOP is connected to the memory card 20 in Fig. 1), which the key would correspond to the entry command key or a return to initiate the

transfer.

Regarding claim 7, Saito further meets the limitations displaying on the display screen of the PD of at least part of the contents of the module(col. 10, "... 30 can also display a still image..").

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 6, 8 and 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al.(US 6,256,063) in view of Yamauchi et al.(US 6,020,982).

Regarding claims 2, 13, 18, 22 and 24, Saito fails to particularly disclose providing circuitry for reformatting a memory module into a state where it can be reused in a digital camera, and to selectively erase images without erasing desired image data, and wherein on a display screen displaying data indicative of a least part of the contents of the memory module.

Yamauchi teaches, in Fig. 107, the method performed on the apparatus with circuitry, for performing selective deletion of image data from a memory card (V 34) or other, either individually or by a range selection of images(V 35, col. 56, lines 40-), therefore displaying of at least part of the contents (Figs. 105-109) of the memory module, as taught by Yamauchi.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating the processing circuitry corresponding to a method of selective deletion of images on the memory module, with the displays indications provided, as taught by Yamauchi.

Regarding claim 6, Saito fails to particularly disclose a display for indicating the status of the repository device.

Yamauchi teaches, providing a status display for indicating the status of the repository device(Fig. 62), in the form of indicators, which indicate the status of memory cards connected to the device or not, by displaying of lights(614 a & 615 a), which indicate the status, of either the cards are inserted and detected {lights ON}, or not inserted {lights off}, as taught by Yamauchi, in order to indicate card insertion or not.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating a display of the status of the repository device as taught by Yamauchi in order to display to the user, the indication of, if

one or more memory modules are detected or not, as taught by Yamauchi.

Regarding claims 8, 11 and claims 15-16 has been analyzed and discussed with respect to the claims above, but, Saito discloses one port, but, fails to particularly disclose a further memory port or a second port for a second memory module.

Yamauchi teaches in Fig. 62, a repository device or editing machine, that is provided with at least two {2} ports(614 & 615) for two modules to be connected at the same time, for receiving memory cards associated with a digital camera(Fig. 2), for transferring images to the editing machine from the modules, as taught by Yamauchi.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating a further port or a second port and memory module, for receiving a second memory card at the same time, as taught by Yamauchi.

Regarding claims 12 and 17, the combination as applied fails to address, wherein the repository comprises a mass storage device, being a hard drive.

The examiner takes official notice that HDDs are well known in the art and therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating a HDD drive for storage into the LapTOP computer for storage of images etc., as is well known to those skilled in

the art.

Regarding claims 14, 19 and 23, Saito as applied provides for LapTOP computer being the mass storage device, and fails to particularly disclose an output port of the mass storage or LapTOP operatively coupled to a user's computer.

The examiner takes official notice that the mass storage device being a LapTOP, would have been obvious to those skilled in the art to provide a port an interface for interfacing with another computer or a user's computer, for transferring etc., stored images, and many other reasons, editing, E-mail etc., as is well known to those skilled in the art.

Regarding claim 20, the combination further discloses wherein the portable device, comprises, a display(LapTOP display, Fig. 1).

8. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al.(US 6,256,063).

Regarding claims 9-10, Saito discloses storage in a computer such as a LapTOP, with storage, but fails to disclose wherein the repository device comprises a hard disk dive, claim 9, and wherein the HDD is removable.

The examiner takes official notice that HDDs are well known and removable HDDs are also well known in the art and therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating a removable HDD



drive for storage into the LapTOP computer for storage of images etc., as is well known to those skilled in the art, and wherein being removable provides advantages of simple and fast replacement of the HDD upon any problems or failure, as is well known to those skilled in the art.

**Contact Fax Information**

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communication intended for entry)

**or:**

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


**Contact Information**

9. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin  
August 20, 2002

  
**VINCENT BOCCIO**  
**PRIMARY EXAMINER**